



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,894	10/31/2003	Jane Dong	67849-0007	4378

7590

06/10/2005

Timur Slonim  
Kaye Scholer LLP  
425 Park Avenue  
New York, NY 10022-3598

EXAMINER
----------

SMALLEY, JAMES N

ART UNIT	PAPER NUMBER
----------	--------------

3727

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

58

# Office Action Summary

Application No. 10/699,894	Applicant(s) DONG, JANE	
Examiner James N Smalley	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

Art Unit: 3727

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites the limitation "the fasteners" in line 1. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7-10, 13-17, 19-21 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy et al. US 5,725,122.

Murphy '122 teaches a lid comprising a container body (2) defining a first opening, a cover (4) having a surface with at least one second opening (48), and a lid/plug (50) with a snapper connection (52) to close the second opening, the second opening is disposed in a cavity (12), and the cover comprises a second cover (42) adapted to fit in the cavity. Examiner notes col. 4, lines 35-40, teaching the cover can be provided with a tear strip.

Regarding claim 25, Examiner notes the claim is rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph for lacking antecedent basis. The claim limitation appears to be drawn from the instant Specification, page 4, paragraph [0013], which states, "[t]he articles may comprise a fastener such as nuts, screws, nails, and bolts, for example." Assuming this is the intended claim limitation, Examiner asserts the limitation is intended use, and does not materially affect the structure of the claimed container. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not

Art Unit: 3727

differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

*Ex parte Masham*, 2 USPQ2d 1647 (1987). The device of Murphy '122 is capable of being used in the intended manner, i.e. for holding fasteners.

5. Claims 1-4, 7, 9-10, 13-16, 19, 21 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hazard US 314,839.

Hazard '839 teaches a can having a first opening, a cover (b) wherein the cover has a second opening (e) within a cavity (d), a cover (B) for the second opening, and a cover (A) fit within the recess.

Regarding claim 25, Examiner notes the claim is rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph for lacking antecedent basis. The claim limitation appears to be drawn from the instant Specification, page 4, paragraph [0013], which states, "[t]he articles may comprise a fastener such as nuts, screws, nails, and bolts, for example." Assuming this is the intended claim limitation, Examiner asserts the limitation is intended use, and does not materially affect the structure of the claimed container. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The device of Hazard '839 is capable of being used in the intended manner, i.e. for holding fasteners.

6. Claims 1, 7, 9 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Richardson et al. US 4,759,478.

Richardson '478 teaches a cover for containers of granular material, comprising a container body with a first opening (shown in phantom in figures 2-3), a cover (10) defining a second opening (43), and a hinged lid (30) to cover the second opening.

Art Unit: 3727

**Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. US 5,725,122.

Murphy '122 does not teach the size of the container.

It would have been obvious to one having ordinary skill in the art to form the container to any suitable size, including one whereby a human hand could fit within the second opening. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

9. Claims 11-12 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. US 5,725,122 as applied above under 35 U.S.C. 102(b) to claims 1 and 13, in view of Richardson et al. US 4,759,478.

Murphy '122 does not teach the lid connected to the cover by a pivotal connection comprising a hinge. However, Examiner notes col. 3, lines 27-35, teaching the opening (48) may serve as a pouring spout, and is to be closed by a plug.

Richardson '478 teaches a plug-type hinged lid, for sealing dispensing openings. Examiner asserts the two references are thus mechanical equivalent plug seals, equally capable of sealing a dispensing opening. One having ordinary skill in the art will recognize these two means of sealing as analogous and equivalent structures. A person having ordinary skill in the art is presumed to have knowledge of all of the relevant prior art in his field of endeavor, as if it were all hanging on his workshop walls. *Filmon Process Corp. v. Spellright Corp.*, 274 F. Supp. 312, 313, 155 USPQ 635, 636 (D.D.C. 1967), *aff'd*, 404 F.2d 1351, 131 U.S. App. D.C. 374, 158 USPQ 533 (1968). Examiner finally notes it

Art Unit: 3727

would be desirable to fix the plug to the container, in order to prevent separating, and possibly losing, the plug from the container.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the closure of Murphy '122, replacing the plug disclosed therein, with the hinged plug seal taught by Richardson '478, because such is a mechanical equivalent equally capable of sealing the dispensing opening. Furthermore, one having ordinary skill would recognize the hinge will prevent the plug from becoming lost or separated from the container.

### **Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 6,712,233	US 5,299,706
US 6,237,765	US 4,838,448
US 6,206,221	US 4,101,047
US 6,056,626	US 3,567,064
US 5,762,228	US 3,552,634
US 5,617,968	US 4,874,103
US 5,385,259	US 3,394,861
US 5,363,978	


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on M-Th 9-6:30, Alternate Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on (571) 272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3727

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jns



**Stephen K. Cronin**  
Primary Examiner